

29 AUG 2000



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Patent Cooperation Treaty  
Legal Office

Address: Assistant Commissioner for Patents  
Box PCT  
Washington, D.C. 20231

Patent Group  
Foley, Hoag & Eliot LLP  
One Post Office Square  
Boston, MA 02109-2170

In re Application of	:	
MITTERER et al.	:	DECISION ON
Application No.: 09/367,459	:	
PCT No.: PCT/AT98/00043	:	PETITION
Int. Filing Date: 27 February 1998	:	
Priority Date: 27 February 1997	:	UNDER 37 CFR 1.10(e)
Attorney's Docket No.: BHV-305.01	:	
For: A METHOD . . . CHROMATOGRAPHY	:	

This decision is in response to applicants' "Petition for Filing Date under §1.10(e)" filed 12 November 1999.

BACKGROUND

On 27 February 1998, applicants filed international application PCT/AT98/00043, which claimed priority of an earlier application filed 27 February 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 September 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 September 1998, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 August 1999.

On 13 August 1999, applicants filed a transmittal letter (including an authorization to charge any additional fees which may be required to Deposit Account No. 06-1448) for entry into the national stage in the United States, which was accompanied by, *inter alia*; the requisite basic national fee; a translation of the international application; a preliminary amendment; an unexecuted declaration; and copies of various papers related to international application PCT/AT98/00043. These papers were assigned US application number 09/367,459 and were date-stamped 13 August 1999.

On 12 November 1999, applicants filed a petition under 37 CFR 1.10(e) requesting that applicants be granted the filing date of 13 August 1999 for the national stage entry from the above-identified international application. The petition was accompanied by copies of the papers

filed 13 August 1999. These papers were assigned US application number 09/423,781. Also, the basic national fee, *inter alia*, was charged to Deposit Account No. 06-1448 based on the authorization in the copy of the transmittal letter.

On 05 April 2000, the United States Designated/Elected Office mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) for application number 09/367,459 indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for filing the oath or declaration later than thirty months from the priority date were required.

On 08 May 2000, applicants filed a RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 accompanied by, *inter alia*, a declaration of inventors and the requisite surcharge.

#### DISCUSSION

As is evident from the above recited facts, the United States Patent and Trademark Office incorrectly treated the submission filed 12 November 1999 as a request for entry into the national stage in the United States. Accordingly, the papers filed on 12 November 1999 have been placed in application number 08/367,459. Also, the fees which were charged to deposit account number 06-1448 based on the authorization in the copy of the transmittal letter filed 12 November 1999 will be refunded to that same deposit account number.

Applicant should use application number **09/367,459** in all future communications with the Patent and Trademark Office in regards to the U.S. national stage of international application PCT/AT98/00043.

The declaration filed 08 May 2000 complies with 37 CFR 1.497(a)-(b). Accordingly, the requirements under 35 USC 371(c) were satisfied as of that date. It is noted that the declaration lists the third named inventor as Oyvind L. Schonberger while the published international application lists the third named inventor as Oyving L. Schonberger. Upon review of a copy of the original Request, however, it appears that the published application contains a typographical error and that the spelling on the declaration is correct. If the spelling on the declaration is not correct, applicants should *immediately* notify the PCT Legal Office.

#### CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.10(e) is **DISMISSED** as moot.

The papers filed on 12 November 1999 have been placed in application number 08/367,459.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including according the application 35 U.S.C. 102(e) and 371(c) dates of 08 May 2000.



Daniel Stemmer  
Legal Examiner  
PCT Legal Office  
Telephone: (703) 308-2066  
Facsimile: (703) 308-6459



Leonard Smith  
Legal Examiner  
PCT Legal Office